REMARKS

Introduction-Claim Status

The Office Action indicates that claims 1-21 are pending, with claims 13-21 being withdrawn from consideration. Of the pending claims under consideration, claims 1, 9, and 10 are in independent form.

Applicant gratefully acknowledges the Examiner's withdrawal of the previous rejections of claims 1-12 (i) under 35 USC § 112, ¶2 for indefiniteness, and (ii) under 35 USC § 112, ¶1, for lacking enablement, and containing new subject matter.

Applicant respectfully requests reconsideration in view of the following remarks.

The 35 U.S.C. §103(a) Rejections

The Office Action rejects claims 1-12 under 35 USC 103(a) as being unpatentable over Lillig et al. (US 4,965,049) in view of Cantantore et al. (US 5,772,963) and in further view of Aziz et al. (Journal of Cellular Biochemistry, Supp. 17G, pp. 247 (1993)).

Applicants respectfully traverse this rejection at least because Cantantore et al. does not qualify as prior art under 35 USC §103(a)/(c). More specifically, Cantantore was filed prior to, but was granted after the original filing date of the instant application, and thus would otherwise qualify as prior art only under 35 USC §102(e). However, Applicant states that the invention claimed in the present application and the

subject matter disclosed by Cantantore were, at the time the present invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Accordingly, Applicant respectfully submits that Cantantore is disqualified under 35 USC §103(c) as prior art for purposes of asserting a 35 USC §103(a) rejection. [Note, the instant application was filed as a CPA after November 29, 1999. (See MPEP §706.02(l)(1)).]. For at least this reason, Applicant respectfully requests that the §103 rejection of claims 1-12 be withdrawn.

The Double Patenting Rejections

1. **Non-Statutory Double Patenting (Based Solely on Improper Timewise Extension of Patent Rights)**

Claims 1-12 are rejected under the judicially created doctrine of double patenting over claims 23-30 and 37-38 of U.S. Patent No. 6,099,469 ("the '469 patent") since the claims, if allowed, would allegedly improperly extend the "right to exclude" already granted in the patent. Applicant respectfully traverses this rejection.

Although there may be some overlap in the subject matter claimed in the instant application (claims 1-12) and '469 patent claims 22-30 and 37-38, the '469 patent claims do not necessarily dominate claims 1-12 of the instant application. More specifically, it is respectfully noted that although compared to claims 1-12 of the instant application, '469 patent claims 23-30 and 37-38 might be considered to be broader at least insofar as they do not explicitly require a sample handling device coupled between immunoassay and clinical chemistry analyzers/instrumentation, these '469 patent

claims might nevertheless possibly be considered to be narrower at least with respect to the reflex algorithm (because the reflex algorithm limitation recited in the '469 patent claim is specifically for providing an indication of myocardial infarction). Accordingly, Applicant respectfully submits that the relationship between the '469 patent claims (i.e., claims 23-30 and 37-38) and the instant application claims 1-12 is factually different from the circumstances present in *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968) such that the alleged nonstatutory double patenting rejection is improper and should be withdrawn.

2. Obviousness-type Double Patenting

Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 23-30 and 37-38 of the '469 patent in view of Lillig et al. (US Patent No. 4,965,049). More specifically, the Office Action asserts that the '469 patent "differs from the instant invention in failing to disclose an automated sample handling device coupled between the analyzers," but that it would have been obvious "to incorporate an automated handling device as taught by Lillig between the analyzers in the system taught by [the '469 patent] to thus, allow sharing fluid transfer therebetween, because it allows for the sytem to operate as a single system having the advantage of increased capacity and versatility." Applicant respectfully traverses this rejection at least on the grounds that there would have been no motivation or suggestion for incorporating the teachings of Lillig into the '469 patent claims as asserted in the Office Action.

Applicant respectfully notes that Lillig relates to a modular clinical chemistry analyzer and neither discloses nor suggests performing tests on a modular analyzer according to a "reflex algorithm," nor performing immunoassays and analyzing biochemical markers. Such a system disclosed by Lillig is thus directed to testing paradigms and problems distinct from those of the invention claimed in the '469 patent, which involves both immunoassays and clinical chemistry assays performed according to a reflex algorithm. Additionally, Applicant respectfully submits that absent Applicant's written description as to the applicability and use of the system of '469 patent claims 23-30 and 37-38 with respect to, *inter alia*, other reflex algorithms, one skilled in the art would not have been motivated to modify the subject matter of '469 patent claims 23-30 and 37-38 as asserted in the Office Action.

Accordingly, for at least the foregoing reasons, Applicant respectfully submits that there would not have been a motivation or suggestion to incorporate Lillig's automatic sample handling device into '469 patent claims 23-30 and 37-38 as alleged in the Office Action. Absent such a suggestion or motivation, the obviousness-type double patenting rejection of claims 1-12 cannot stand, and should be withdrawn.

Conclusion

In view of the above remarks, Applicants respectfully submit that the application is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections is respectfully requested and allowance of all pending claims is respectfully submitted.

If any outstanding issues remain, or if the Examiner has any suggestions for expediting allowance of this application, the Examiner is invited to contact the undersigned at the telephone number below.

The Examiner's consideration of this matter is gratefully acknowledged.

Respectfully submitted,

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Date: December 27, 2004 By: _____

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